

## **REMARKS**

Claims 22-88 are pending in the Application and all were rejected in the final Office action mailed December 28, 2007. Claims 22, 39, 58, 73, and 86 are amended, and new claims 89-104 are added by this response. Claims 22, 39, 58 and 73 are independent claims. Claims 23-38 and 93-96, claims 40-57 and 97-100, claims 59-72 and 101-104, and claims 74-92 depend from independent claims 22, 39, 58 and 73, respectively.

The Applicants respectfully request reconsideration of the pending claims 22-88, and consideration of new claims 89-104, in light of the following remarks.

### **Amendments to the Claims**

Claims 22, 39, 58, 73, 86 have been amended as set forth above. Support for these amendments may be found, for example, at pages 66-72 and 271-289, and Figs. 1C, 2, 21-25, and 56a of the Application. Applicants respectfully submit that these amendments do not add new matter.

### **Rejections Of Claims**

Applicants respectfully note that all of the rejections are based upon obviousness.

Claims 22, 24, 25, 28-30, 33-39, 41, 42, 45-47, 50-58, 61, 63-66, 69-73, 76, and 82-86 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken (WO 91/08629) in view of Richter, et al. (US 6,104,706, hereinafter "Richter"). Claims 23, 40, and 81 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Cripps (US 5,838,730). Claims 26, 27, 31, 32, 43, 44, 48, 49, 59, 60, 62, 74 and 75 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Perkins (US 5,159,592). Claim 67 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Callon et al. (US 5,251,205, hereinafter "Callon"). Claim 68 was rejected under 35 U.S.C. §103(a)

as being unpatentable over Berken in view of Richter and Reece et al. (US 5,915,214, hereinafter "Reece"). Claims 77-79 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Lewen et al. (US 5,341,374, hereinafter "Lewen"). Claim 80 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter, Lewen, and McKee et al. (US 5,477,531, hereinafter "McKee"). Claims 87 and 88 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Focsaneanu et al. (US 5,610,910, hereinafter "Focsaneanu").

Claims 22, 28, 29, 33, 35-39, 45, 46, 50, 53-58, 63, 66, and 69-72 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton (US RE38787E) in view of Richter. Claims 23, 24, 40, and 41 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton in view of Richter and Cripps. Claims 25 and 42 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton in view of Richter and Honig (US 5,481,533). Claims 26, 27, 30-32, 43, 44, 47-49, and 59-62 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton in view of Richter and Perkins (US 5,159,952). Claims 34, 51, 52, 64, and 65 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton in view of Richter and Weaver (US 5,956,673). Claim 67 was rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton in view of Richter and Callon (US 5,251,205).

Claims 22, 39, 58, 63, and 73 were rejected under 35 U.S.C. 103(a) as being unpatentable over Berken and Shachar (US 5,764,736).

Applicants respectfully traverse the rejections. Notwithstanding, Applicants have amended independent claims 22, 39, 58 and 73 as set forth above, rendering the rejections of the instant Office action moot.

Applicants respectfully submit that claims 22, 39, 58, and 78, and, any claims that depend therefrom, define allowable subject matter, for at least the reasons set forth during prior prosecution, and in addition, for the reasons set forth below.

**I. The Proposed Combinations Of Berken And Richter Does Not Render Claims 22, 24, 25, 28-30, 33-39, 41, 42, 45-47, 50-58, 61, 63-66, 69-73, 76, And 82-86 Unpatentable**

With regard to amended claims 22, 39, 58, and 73, Applicants respectfully submit that the proposed combination of Berken and Richter does not teach, suggest, or disclose, at least, "...wherein the portable terminal device evaluates a message wirelessly received from the at least one access device and sends to the at least one access device an indication of a data rate based on the evaluation;...", and "...wherein the at least one access device selects a data rate for transmitting digital voice packets and digital data packets to the portable terminal device, based upon the indication of a data rate...", as recited by amended claim 22. Applicants respectfully submit that neither Berken nor Richter teach or suggest these features of Applicants' amended claim 22, and that it necessarily follows that the combination of Berken and Richter also cannot teach or suggest these features of Applicants' amended claim 22.

In addition, Applicants respectfully submit that the proposed combination of Berken and Richter does not teach, suggest, or disclose, at least, "...wherein the at least one portable terminal evaluates a message wirelessly received from the at least one access device and sends to the at least one access device an indication of a data rate based on the evaluation;...", and "...wherein the at least one access device selects a data rate for transmitting one or both of packets comprising digital representations of sound and packets comprising digital data to the at least one portable terminal, based upon the indication of a data rate....", as recited by Applicants' amended claim 39. Applicants respectfully submit that neither Berken nor Richter teach or suggest at least these aspects of Applicants' amended claim 39, and that it necessarily follows that the combination of Berken and Richter also cannot teach or suggest at least these aspects of Applicants' amended claim 39.

Further, Applicants respectfully submit that the proposed combination of Berken and Richter does not teach, suggest, or disclose, at least, "...wherein the communication device evaluates a message wirelessly received from the at least one

access device and sends to the at least one access device an indication of a data rate based on the evaluation;...”, and “...wherein the at least one access device selects a data rate for transmitting digital voice packets to the communication device, based upon the indication of a data rate....”, as recited by Applicants’ amended claim 58. Applicants respectfully submit that neither Berken nor Richter teach or suggest at least these features of Applicants’ amended claim 58, and that it necessarily follows that the combination of Berken and Richter also cannot teach or suggest at least these features of Applicants’ amended claim 58.

Applicants also respectfully submit that the proposed combination of Berken and Richter does not teach, suggest, or disclose, at least, “at least one processor operating to:...evaluate a message wirelessly received from the at least one access device;...”, “...send to the at least one access device an indication of a data rate based on the evaluation;...”, and “...receive digital voice packets from the at least one access device at a data rate selected by the at least one access device based upon the indication of a data rate;...”, as recited by Applicants’ amended claim 73. Applicants respectfully submit that neither Berken nor Richter teach or suggest at least these aspects of Applicants’ amended claim 73, and that it necessarily follows that the combination of Berken and Richter also cannot teach or suggest at least these aspects of Applicants’ amended claim 73.

Therefore, for at least the reasons set forth above, Applicants believe that the Berken and Richter, taken alone or in combination, fail to render unpatentable amended independent claims 22, 39, 58, and 73, that amended claims 22, 39, 58, and 73 are allowable over Berken and Richter, and that Berken and Richter also do not render unpatentable claims 23-38, 40-57, 59-72, and 93-104, that depend therefrom. Accordingly, Applicants respectfully request that the rejection of claims 22, 24, 25, 28-30, 33-39, 41, 42, 45-47, 50-58, 61, 63-66, 69-73, 76, and 82-86 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

**II. The Proposed Combinations Of Berken and Richter With Cripps, Perkins, Callon, Reece, Lewen, McKee, And Focsaneanu Do Not Render Claims 23, 26, 27, 31, 32, 40, 43, 44, 48, 49, 59, 60, 62, 67, 68, 74, 75, 77-81, 87 and 88 Unpatentable**

Applicants respectfully submit that Berken and Richter, when combined with any or all of Cripps, Perkins, Callon, Reece, Lewen, McKee, and Focsaneanu do not render independent claims 22, 39, 58, and 73 unpatentable, for at least the reasons set forth above. Accordingly, Applicants respectfully submit that the proposed combinations of references also do not render unpatentable claims 23-38, 40-57, 59-72, and 93-104, which depend either directly or indirectly from independent claims 22, 39, 58, and 73, for at least the same reasons. Therefore, Applicants respectfully request that the rejections of claims 23, 26, 27, 31, 32, 40, 43, 44, 48, 49, 59, 60, 62, 67, 68, 74, 75, 77-81, 87 and 88 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

**III. The Proposed Combination Of Sainton And Richter Does Not Render Claims 22, 28, 29, 33, 35-39, 45, 46, 50, 53-58, 63, 66, And 69-72 Unpatentable**

As an initial matter, Applicants assume that the Office intended to reject independent claim 73 instead of/in addition to dependent claim 63 over Sainton and Richter. If this assumption is in error, Applicants respectfully submit that the Office has failed establish a prima facie case of obviousness with respect to claims 73-88, that the Office has failed to show how and why the proposed combination of Sainton and Richter renders independent claim 73 and dependent claims 74-88 unpatentable, and that independent claim 73 and any claims that depend therefrom are allowable over Sainton and Richter.

With regard to amended claims 22, 39, 58, and 73, Applicants respectfully submit that the proposed combination of Sainton and Richter does not teach, suggest, or disclose, at least, "...wherein the portable terminal device evaluates a message wirelessly received from the at least one access device and sends to the at least one access device an indication of a data rate based on the evaluation;...", and "...wherein the at least one access device selects a data rate for transmitting digital voice packets

and digital data packets to the portable terminal device, based upon the indication of a data rate...”, as recited by amended claim 22. Applicants respectfully submit that neither Sainton nor Richter teach or suggest these features of Applicants’ amended claim 22, and that it necessarily follows that the proposed combination of Sainton and Richter also cannot teach or suggest these features of Applicants’ amended claim 22.

In addition, Applicants respectfully submit that the proposed combination of Sainton and Richter does not teach, suggest, or disclose, at least, “...wherein the at least one portable terminal evaluates a message wirelessly received from the at least one access device and sends to the at least one access device an indication of a data rate based on the evaluation;...”, and “...wherein the at least one access device selects a data rate for transmitting one or both of packets comprising digital representations of sound and packets comprising digital data to the at least one portable terminal, based upon the indication of a data rate....”, as recited by Applicants’ amended claim 39. Applicants respectfully submit that neither Sainton nor Richter teach or suggest at least these aspects of Applicants’ amended claim 39, and that the proposed combination of Sainton and Richter by definition cannot teach or suggest at least these aspects of Applicants’ amended claim 39.

Further, Applicants respectfully submit that the proposed combination of Sainton and Richter does not teach, suggest, or disclose, at least, “...wherein the communication device evaluates a message wirelessly received from the at least one access device and sends to the at least one access device an indication of a data rate based on the evaluation;...”, and “...wherein the at least one access device selects a data rate for transmitting digital voice packets to the communication device, based upon the indication of a data rate....”, as recited by Applicants’ amended claim 58. Applicants respectfully submit that neither Sainton nor Richter teach or suggest at least these features of Applicants’ amended claim 58, and that, accordingly, the proposed combination of Sainton and Richter also cannot teach or suggest at least these features of Applicants’ amended claim 58.

Finally, Applicants respectfully submit that the proposed combination of Sainton and Richter does not teach, suggest, or disclose, at least, “at least one processor operating to:...evaluate a message wirelessly received from the at least one access device;...”, “...send to the at least one access device an indication of a data rate based on the evaluation;...”, and “...receive digital voice packets from the at least one access device at a data rate selected by the at least one access device based upon the indication of a data rate;...”, as recited by Applicants’ amended claim 73. Applicants respectfully submit that neither Sainton nor Richter teach or suggest at least these aspects of Applicants’ amended claim 73, and that it necessarily follows that the proposed combination of Sainton and Richter also cannot teach or suggest at least these aspects of Applicants’ amended claim 73.

Therefore, for at least the reasons set forth above, Applicants believe that the Sainton and Richter references, taken alone or in combination, fail to render unpatentable amended independent claims 22, 39, 58, and 73, that amended claims 22, 39, 58, and 73 are allowable over Sainton and Richter, and that Sainton and Richter also do not render unpatentable claims 23-38, 40-57, 59-72, and 93-104, that depend therefrom. Accordingly, Applicants respectfully request that the rejection of claims 28, 29, 33, 35-38, 45, 46, 50, 53-57, 63, 66, 69-72, and 74-88 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### **IV. The Proposed Combinations Of Sainton and Richter With Cripps, Honig, Perkins, Weaver and Callon Do Not Render Claims 23-27, 30-32, 34, 40-44, 47-49, 51, 52, 59-62, 64 And 67 Unpatentable**

Applicants respectfully submit that Sainton and Richter, when combined with any or all of Cripps, Honig, Perkins, Weaver and Callon do not render independent claims 22, 39, 58, and 73 unpatentable, for at least the reasons set forth above. Accordingly, Applicants respectfully submit that the proposed combinations of references also do not render unpatentable claims 23-38, 40-57, 59-72, and 93-104, which depend either directly or indirectly from independent claims 22, 39, 58, and 73, for at least the same reasons. Accordingly, Applicants respectfully request that the rejections of claims 23-

27, 30-32, 34, 40-44, 47-49, 51, 52, 59-62, 64 and 67 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

**V. The Proposed Combinations Of Berken And Shachar Does Not Render Claims 22, 39, 58, 63, And 73 Unpatentable**

With regard to amended claims 22, 39, 58, and 73, Applicants respectfully submit that the proposed combination of Berken and Shachar does not teach, suggest, or disclose, at least, "...wherein the portable terminal device evaluates a message wirelessly received from the at least one access device and sends to the at least one access device an indication of a data rate based on the evaluation;...", and "...wherein the at least one access device selects a data rate for transmitting digital voice packets and digital data packets to the portable terminal device, based upon the indication of a data rate...", as recited by amended claim 22. Applicants respectfully submit that neither Berken nor Shachar teach or suggest these features of Applicants' amended claim 22, and that, by definition, the combination of Berken and Shachar also cannot teach or suggest these features of Applicants' amended claim 22.

Applicants also respectfully submit that the proposed combination of Berken and Shachar does not teach, suggest, or disclose, at least, "...wherein the at least one portable terminal evaluates a message wirelessly received from the at least one access device and sends to the at least one access device an indication of a data rate based on the evaluation;...", and "...wherein the at least one access device selects a data rate for transmitting one or both of packets comprising digital representations of sound and packets comprising digital data to the at least one portable terminal, based upon the indication of a data rate....", as recited by Applicants' amended claim 39. Applicants respectfully submit that neither Berken nor Shachar teach or suggest at least these aspects of Applicants' amended claim 39, and that it necessarily follows that the combination of Berken and Shachar also cannot teach or suggest at least these aspects of Applicants' amended claim 39.



In addition, Applicants respectfully submit that the proposed combination of Berken and Shachar does not teach, suggest, or disclose, at least, "...wherein the communication device evaluates a message wirelessly received from the at least one access device and sends to the at least one access device an indication of a data rate based on the evaluation;...", and "...wherein the at least one access device selects a data rate for transmitting digital voice packets to the communication device, based upon the indication of a data rate....", as recited by Applicants' amended claim 58. Applicants respectfully submit that neither Berken nor Shachar teach or suggest at least these features of Applicants' amended claim 58, and that it necessarily follows that the combination of Berken and Shachar also cannot teach or suggest at least these features of Applicants' amended claim 58.

Applicants also respectfully submit that the proposed combination of Berken and Shachar does not teach, suggest, or disclose, at least, "at least one processor operating to:...evaluate a message wirelessly received from the at least one access device;...", "...send to the at least one access device an indication of a data rate based on the evaluation;...", and "...receive digital voice packets from the at least one access device at a data rate selected by the at least one access device based upon the indication of a data rate;...", as recited by Applicants' amended claim 73. Applicants respectfully submit that neither Berken nor Shachar teach or suggest at least these aspects of Applicants' amended claim 73, and that, by definition, the combination of Berken and Shachar also cannot teach or suggest at least these aspects of Applicants' amended claim 73.

Therefore, for at least the reasons set forth above, Applicants believe that the Berken and Shachar, taken alone or in combination, fail to render unpatentable amended independent claims 22, 39, 58, and 73, that amended claims 22, 39, 58, and 73 are allowable over Berken and Shachar, and that Berken and Shachar also do not render unpatentable claims 23-38, 40-57, 59-72, and 93-104, that depend therefrom. Accordingly, Applicants respectfully request that the rejection of claims 22, 39, 58, 63, and 73 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

### **Newly Added Claims**

Applicants have added new claims 89-104. Dependent claims 89-92, 93-96, 97-100, and 101-104 depend, respectively, from claims 73, 22, 39, and 58.

Support for new claims 89-104 may be found, for example, at pages 66-72 and Figs. 1C, 2, and 21-25 of the Application. Applicants respectfully submit that no new matter is added by these new claims.

Additional claim fees in the amount of  $16 \times \$50 = \$800$  are believed to be due.

### **Conclusion**

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of pending claims 22-104 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000. If the Examiner maintains his rejections, the Applicants hereby respectfully request an interview with the Examiner.

The Commissioner is hereby authorized to charge the \$800 for additional claims, and any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 13-0017.

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A Notice of Allowability is courteously solicited.

Respectfully submitted,

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